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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/708,085 | 02/06/2004 | James F. Macier | BMCA9159.357 | 2084 |
| 27062 | 7590 | 01/12/2006 | EXAMINER | |
| OSLER, HOSKIN & HARCOURT LLP (BRP2) 2100 -1000 DE LA GAUCHETIERE ST. WEST MONTREAL, H3B4W5 CANADA | | | VASUDEVA, AJAY | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3617 | |

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/708,085 | MACIER ET AL. | |
| | Examiner | Art Unit | |
| | Ajay Vasudeva | 3617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 and 34-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-33 and 41-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of claims 18-33 and 41-54 (Group II) in the reply filed on 10/26/2005 is acknowledged. Claims 1-17 and 34-40 (Group I and Group III) are therefore withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 18-28 and 41-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Wolaver (US 6,875,066 B2).

Wolaver shows an outboard motor having an engine [14], an engine cover [12], as well as first and second midsection covers [17, 19]. At least three silencers [26, 28, 30] are disposed in the volume defined between the engine and the covers such that the silencers are molded to substantially match the contour of the respective cover. The silencers are made of closed-cell foams such as polyurethane, neoprene, polyethylene, polypropylene etc. (col. 4, lines 50-55), and are therefore considered to be waterproof.

The foam used for making each of the silencers is provided with a density gradient, such that the density at the outer surface of the foam is greater than the density at the inner surface (see col. 5, fig. 5). Therefore, the material at the outer surface of the first silencer has a higher density than at least the material at the inner surface of the second silencer (claim 19). The waterproof ability of the foam being proportional to its density, the outer surface of the first silencer provides greater waterproofing than at least the inner surface of the second silencer (claim 24). The density of material used for making the silencers is as high as 30 pounds per cubic foot (col. 5, line 49).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolaver (US 6,875,066 B2).

Wolaver shows an outboard motor, as above, but does not show (i) the motor as being incorporated in a watercraft (claim 29), or (ii) the motor emitting a certain decibel at a specific rpm (claims 30-33).

The examiner takes Official notice that use of outboard motors for propelling watercraft is old and well known in the art. It would have been obvious for one skilled in the art at the time of the invention to removably attach the motor to a non-motorized craft in order to propel it efficiently, while also being able to remove the motor when not in use.

Regarding the level of noise produced by the motor at a specific rpm, it is noted that such is a function of diverse factors – such as the age and maintenance condition of the engine,

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the gear/transmission ratio, the load on the engine, the fuel and lubricant used, the condition of the air intake and exhaust systems, the atmospheric temperature condition at the time of engine startup or running etc. Therefore, it would have been inherent for the engine to emit a noise corresponding to the specific rpm, as being claimed, for a certain combination of such diverse factors.


Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay Vasudeva whose telephone number is (571) 272-6689. The examiner can normally be reached on Monday-Friday 12:00 -- 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ajay Vasudeva
Examiner
Art Unit 3617


AJAY VASUDEVA 1/9/08
PATENT EXAMINER